

REMARKS

Claims 1-22 are presently pending in this application. Claims 1-15 and 17-22 have been amended to more particularly define the claimed invention.

It is noted that the amendments are made only to more particularly define the invention and not for distinguishing the invention over the prior art, for narrowing the scope of the claims, or for any reason related to a statutory requirement for patentability. It is further noted that, notwithstanding any claim amendments made herein, Applicant's intent is to encompass equivalents of all claim elements, even if amended herein or later during prosecution.

Claims 1, 4, 8, 10, 12, 15 and 17-22 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 1, 4, 8, 10, 12, 15 and 17-22 has been amended in a manner believed fully responsive to all points raised by the Examiner.

Claims 1-22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Stuntebeck et al., U.S. Pat. No. 6,065,016, further in view of Dunworth et al., U.S. Pat. No. 5,930,474.

This rejection is respectfully traversed in view of the following discussion.

I. APPLICANT'S CLAIMED INVENTION

The claimed invention (as defined, for example, by independent claim 1) is directed to a map information providing device for providing map information of a destination a user requests, in response to a request from a user terminal device through a network, including means for registering a second destination which a map information provider originally selects, in addition to a first destination of a dealer who is under contract with the map

information provider, the first destination published on a map, as map information, and means for checking whether the requested destination is the first destination or the second destination when the map information of the requested destination is requested by the user terminal device. When a user requested destination is checked as the first destination, the map information is provided free of charge. However, when the requested destination is checked as the second destination, the user terminal device is notified that the second destination requires a charge, receiving confirmation of a user's payment of the charge, confirming payment acceptance at the user terminal device, performing billing processing, and providing the map information. Further, when refusal of payment of the charge is confirmed by the user terminal device, the connection is finished.

Conventionally, when a user requests a destination from a mapping system, only maps are published that include map information of shops and companies which contract with the map information provider. Accordingly, the user requested map information is restricted to only the shops and companies contracting with the map information provider. This conventional technique is limited because the user requested map information is restricted to the shops and companies contracting with the map information provider. (Application at page 1, line 17 to page 2, line 2).

The claimed invention (e.g., as recited in claims 1, 4, 8, 10, 12, 15 and 17-22), on the other hand, includes “*means for registering a first destination which a map information provider originally selects, in addition to a second destination...the first and second destinations published on a map, as map information,*” “*means for checking whether the requested destination is the first destination or the second destination when the map information of the requested destination is requested by the user terminal device,*” and

“wherein, when the requested destination is checked as the first destination, the map information is provided free of charge.” These aspects of the invention are important for the system to distinguish between user requested paid destinations and user requested to free destinations. (Application at page 13, line 46 to page 14, line 15.)

II. THE ALLEGED PRIOR ART REJECTION

35 U.S.C. § 103(a) Rejection over Stuntebeck et al., U.S. Pat. No. 6,065,016 in view of Dunworth et al., U.S. Pat. No. 5,930,474

The Examiner alleges that Stuntebeck et al., U.S. Pat. No. 6,065,016, (Stuntebeck), in view of Dunworth et al., U.S. Pat. No. 5,930,474, (Dunworth), teaches the invention of claims 1-22. Applicant submits, however, that Stuntebeck in view of Dunworth does not teach or suggest each and every element and feature of the claimed invention.

The Examiner alleges that one of ordinary skill in the art would have been motivated to modify Stuntebeck with the teaching from Dunworth to form the invention of claims 1-22. Applicant submits, however that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention.

Applicant respectfully submits that Stuntebeck would not have been combined with Dunworth as alleged by the Examiner. Indeed, these references are non-analogous because they are completely unrelated, (Stuntebeck is directed to universal directory service that provides communication addresses of individuals associated with numerous different institutions, is accessed via more than one communication channel, and communicates with one or more data sources to provide a user with directory information and supplemental information such as company name, logo, and specialty, whereas, Dunworth is directed to a

software interface that organizes information predicated upon the geographical area of the resources about which the information is desired), and no person of ordinary skill in the art would have considered combining these disparate references, absent impermissible hindsight.

In fact, Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner.

Therefore, Applicant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner. Therefore, the Examiner has failed to make a prima facie case of obviousness.

The teaching of Stuntebeck discloses the invention of a universal directory service (UDS) that provides communication addresses of individuals associated with numerous different institutions, is accessed via more than one communication channel, and communicates with one or more data sources to provide a user with directory information and supplemental information such as company name, maps, logo, and specialty.

Stuntebeck teaches “maps” as supplemental information:

In addition to the numerous communication addresses of an individual, the UDS server also provides supplemental information such as the type of business the individual or company is engaged in, specialties or particular accomplishments, business hours, prices, organizational charts, responsibilities of the individual within the company, and maps logos, trademarks, and other graphical images. (Emphasis added.) (Column 2, lines 30-36 and column 4, lines 46-54.)

Stuntebeck teaches supplemental information delivered separately and upon user request and after delivery of initial user requested information, i.e., user requested communication addresses:

Rather than providing all of the directory information at once, the UDS first transmits the communication addresses of the matching responses. Then, upon the user's request, the corresponding supplemental information is transmitted to the user. (Column 6, lines 29-34.)

The Office Action analogizes Applicant's amended first destination with the map information of Stuntebeck's supplemental information. However, the Office Action fails to address, and Stuntebeck fails teach or suggest, "means for registering a first destination which a map information provider originally selects." Stuntebeck teaches a user that requests a communication address of the UDS. "The query form enables the user to input information identifying the individual of interest." Stuntebeck at column 5, lines 12-13.

Further, Stuntebeck fails to teach a "requested destination is requested by the user terminal device," if the Examiner analogizes Applicant's first destination with the map information of Stuntebeck's supplemental information. Applicant is claiming three separate "destinations": *a requested destination, a second destination, and a first destination.* Examiner's prior art rejection of Stuntebeck only deals with a single destination, i.e., Applicant's "first destination."

Therefore, Stuntebeck fails to teach or suggest, "means for checking whether the requested destination is the first destination or the second destination when the map information of the requested destination is requested by the user terminal device," since Stuntebeck only discloses a single user requested address information as supplemental information that includes a map.

Furthermore, since Stuntebeck fails to teach or suggest any means for checking at least two destinations, Stuntebeck fails to teach or suggest, "*wherein, when the requested destination is checked as the first destination, the map information is provided free of charge.*" Stuntebeck teaches the delivery of communication addresses of the matching responses separate from supplemental information that may be subject to a two-tiered billing system. Nowhere in Stuntebeck is disclosed any means for checking, that is, comparing the

analytical values, of at least two destinations.

Further, since Stuntebeck teaches map information comprising supplemental information subject to a two-tiered billing system, as disclosed above in column 6, lines 29-37. Therefore, the map information of Stuntebeck cannot be equivalent to Applicant's "*first destination*," since information requested by the user in Stuntebeck is delivered as "communication addresses" and not as "supplemental information."

Along the same lines, Stuntebeck fails to teach or suggest, "*the first and second destinations published on a map, as map information*," since Stuntebeck only discloses "*a first destination*," and fails to teach anywhere map information of two discrete destinations being published on a single map. Stuntebeck merely discloses discrete maps associated with particular addresses to be displayed as supplemental information when that particular address is requested by a user.

Applicant respectfully submits that Dunworth would not have been combined with Stuntebeck and even if combined, the combination would not teach or suggest each and every element of the claimed invention, since Stuntebeck, as pointed out above, fails to teach or suggest, "*means for registering a first destination which a map information provider originally selects, in addition to a second destination...the first and second destinations published on a map, as map information*," "*means for checking whether the requested destination is the first destination or the second destination when the map information of the requested destination is requested by the user terminal device*," and "*wherein, when the requested destination is checked as the first destination, the map information is provided free of charge*," and Dunworth fails to overcome the deficiencies of Stuntebeck.

Therefore, Applicant respectfully requests Examiner to reconsider and withdraw this

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rejection since the alleged prior art reference fails to teach or suggest each and every element and feature of Applicant's claimed invention.

III. FORMAL MATTERS AND CONCLUSION

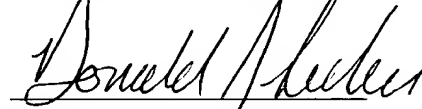
In view of the foregoing, Applicant submits that claims 1-22, all of the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

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Respectfully Submitted,



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